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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/752,733	01/07/2004	Norman H. Margolus	11656-004009	4737
26161	7590	01/03/2007		
FISH & RICHARDSON PC P.O. BOX 1022 MINNEAPOLIS, MN 55440-1022			EXAMINER EHICHIOYA, FRED I	
			ART UNIT	PAPER NUMBER
			2162	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	01/03/2007	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

**Office Action Summary**

Application No.

10/752,733

Applicant(s)

MARGOLUS, NORMAN H.

Examiner

Fred I. Ehichioya

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 111 - 113 and 164 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 111 - 113 and 164 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

1. This Office Action is responsive to communication filed October 10, 2006.
2. Claims 111 –113 and 164 are pending in this Office Action.

### ***Response to Arguments***

3. Applicant's arguments with respect to claims 111 – 113 and 164 have been considered but are moot in view of the new ground(s) of rejection.

### ***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 164 is rejected under 35 U.S.C 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 164, it recites the limitation of “an expiration time is assigned to the entity version and no action taken by the client can change the expiration time assigned to the entity version to an earlier time”. Applicant discloses on page 29, lines 1 – 2 of the specification: “To change the expiration time of a version, its datablocks are first incremented using the new expiration time, and then decremented using the old.”

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This is contradictory to claim 164; therefore, claim 164 is a negative limitation that rendered the claims indefinite because it is an attempt to claim the invention by excluding what the inventors did not invent rather than distinctly and particularly pointing out what they did invent. *In re Schechter*, 205F.2d 185,98 USPQ 144 (CCPA) 1953). Also, this claimed limitation defines the invention in terms of what it was not, rather than pointing out the invention; therefore, renders claim 164 indefinite.

"The primary purpose of this requirement of definiteness of claim language is to ensure that the scope of the claims is clear so the public is informed of the boundaries of what constitutes infringement of the patent. A secondary purpose is to provide a clear measure of what applicants regard as the invention so that it can be determined whether the claimed invention meets all the criteria for patentability and whether the specification meets the criteria of 35 U.S.C. 112, first paragraph with respect to the claimed invention" MPEP 2173.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 111 – 113 are rejected under 35 U.S.C. 103(a) as being unpatentable over US Pub. No. 2003/0177356 issued to Noel Abela (Hereinafter “Abela”) in view of US Pub. No. 2004/0153431 issued to Kulvir Singh Bhogal (Hereinafter “Bhogal”).

Regarding claim 111, Abela teaches a method by which a client connected to a data repository over a lower speed network connection may provide higher speed access to a data item for application processing than is possible over the relatively low speed connection to the network, the method comprising:

determining a digital fingerprint of the data item (page 6, [0083]: “one can have the individual's fingerprints scanned by a palm reader at the checkpoint”);

testing for whether the data item is already stored in a repository by comparing the digital fingerprint of the data item to digital fingerprints of data items already in the repository (page 6, [0083]: “The resulting digital mark is stored locally in volatile memory by the client system. Apart from photo and personal details, the client system in this case, asks the user's home uID database for the individual's digital biometric mark. It then compares the mark received to the one in its local volatile memory”);

only if the data item is not already in the repository, transferring the data item over the lower speed connection from the client to the repository (page 6, [0083]: "one can have the individual's fingerprints scanned by a palm reader at the checkpoint. The resulting digital mark is stored locally in volatile memory by the client system");

making a higher speed connection between an application server and the data repository (page 3, [0055]).

executing an application on the application server to process the data item stored on the data repository (page 3, [0056]: "individuals who, in FIG. 1 are represented by their uID identifiers 109-113 communicate and interact with one another using a number of software applications. These applications run on various types of personal devices 114-118 which are connected to the Internet"); and

returning at least some of the processed data to the client across the lower speed connection (page 6, [0085]: "Each individual uID database executes its own search by matching the supplied photo with all the photos on file and replies with its search results").

Abela does not explicitly teach expiration time as claimed.

Bhogal teaches assigning an expiration time to the data item (page 5, #3: "assigning a pre-designated expiration date"), before which time deletion is prohibited (page 4, [0049]: "If the time period has not expired, the process proceeds to step 812 to display a message prohibiting deletion of the message"); and

It would have been obvious to one of ordinary skill in the data processing art at the time of the present invention to combine teaching of the cited references because

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Bhogal's teaching of "expiration time" would have allowed Abela's system to monitor and prevent unexpired data for deletion. The motivation is that data integrity is preserved.

Regarding claim 112, Bhogal teaches rules governing expiration (page 4, [0049]: the rule in this case is that data cannot be deleted for 20 days from the data of receipt) and deletion are distributed among a plurality of storage sites (Fig.1 and page 2, [0022]).

Regarding claim 113, Bhogal teaches the expiration time assigned to the data item (page 5, #3: "assigning a pre-designated expiration date") depends upon expiration times assigned by the client programs (page 4, [0049]: "If the time period has not expired, the process proceeds to step 812 to display a message prohibiting deletion of the message").


Regarding claim 164, Bhogal teaches wherein the client deposits an entity version into the disk-based distributed data storage system (Fig. 4 steps 400 and 404) and an expiration time is assigned to the entity version and no action taken by the client can change the expiration time assigned to the entity version to an earlier time (page 4, [0049]: "If the time period has not expired, the process proceeds to step 812 to display a message prohibiting deletion of the message").

**Conclusion**


5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Fred I. Ehichioya whose telephone number is 571-272-4034. The examiner can normally be reached on M - F 8:00 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John E. Breene can be reached on 571-272-4107. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300:

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Fred I. Ehichioya   
Patent Examiner  
Art Unit 2162

December 17, 2006

  
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